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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/905,626	07/13/2001	Changguan Fan	42390P12061	3702
21906	7590	05/12/2005	EXAMINER	
TROP PRUNER & HU, PC 8554 KATY FREEWAY SUITE 100 HOUSTON, TX 77024			SHIN, KYUNG H	
			ART UNIT	PAPER NUMBER
			2143	

DATE MAILED: 05/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/905,626

Applicant(s)

FAN ET AL.

Examiner

Kyung H. Shin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 10-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 10-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/13/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is responding to amendment (RCE) dated 4/20/2005.
2. Claims **1 - 13** are pending. Independent claims are **1, 10**. Claims **1, 10** have been amended. Claims **2, 3, 11, 12** were previously presented. Claims **4 - 9** have been canceled. Claim **13** is new.

### **Response to Remarks**

3. Applicants argues that the prior art does not disclose the usage of an entity to automatically obtain an IP address as part of the network appliance's configuration. Kikinis prior art specifies a network connected appliance interfacing through an Internet Service Provider (ISP) and operational within an Internet communications network environment for its configuration. (see Kikinis col. 3, lines 22-27: apparatus (i.e. Internet device) capable of obtaining and installation of configuration information) Kikinis in view of O'Toole discloses the usage of a Dynamic Host Configuration Protocol (DHCP) server utilized to automatically obtain configuration information such as an IP address. (see O'Toole col. 7, lines 46-51; col. 18, lines 6-14: DHCP IP address acquisition) The obtained IP address utilized by the network appliance for its future communications over accessible networks.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1, 2, 10, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kikinis (US Patent No. 6,622,169) in view of O'Toole et al. (US Patent No. 6,345,294).**

**Regarding Claim 1 (Currently Amended), Kikinis discloses a method, comprising:**

- a) receiving, at an Internet Service Provider, a request from a client device for Internet service; (see Kikinis col. 3, lines 28-32: user (i.e. client) request for Internet access configuration information from ISP (i.e. Internet Service Provider))
- b) downloading provisioning (see Kikinis col. 5, lines 1-6: device (i.e. Internet based) configuration equivalent to provisioning; Applicant Specification, Paragraph [0006], lines 6-8: “ ... *the terms “configure” and “provision” will be used somewhat interchangeably ...* ”) data to the client device to enable the client device to receive an Internet service from said Internet Service Provider; (see

Kikinis col. 6, line 66 - col. 7, line 8: download configuration information to complete Internet access setup (i.e. Internet service)) and

- c) Kikinis discloses automatic configuration of a network capable device (i.e. Internet appliance). (see Kikinis col. 3, lines 22-27: apparatus (i.e. Internet device) capable of obtaining and installation of configuration information) Kikinis does not specifically disclose automatic retrieval of an IP address from a DHCP address server. O'Toole discloses automatically providing said client device with an Internet protocol address. (see O'Toole col. 7, lines 46-51; col. 18, lines 6-14: DHCP server for automatic IP address configuration)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kikinis to obtain a dynamic IP address for Internet communications access as taught by O'Toole. One of ordinary skill in the art would be motivated to employ O'Toole in order to remotely configure a network connected (i.e. Internet) appliance obtaining its configuration information from a network server to achieve easier usage and greatly reduce administration costs. (see O'Toole col. 1, lines 19-21: “ ... *Internet media appliances or servers characterized by ease of use and low cost of administration* ... ”)

**Regarding Claim 2** (Previously Presented), Kikinis discloses the method of claim 1, further comprising: authenticating the generically pre-provisioned client device; and the downloading being conditioned upon the authenticating. (see Kikinis col. 7, lines 4-6; col. 8, lines 52-57: authentication information required before Internet access, setup

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completed)

**Claims 4-9 (Canceled).**

**Regarding Claim 10 (Currently Amended),** Kikinis discloses a processor-based system comprising:

- a) a provisioning server (see Kikinis col. 3, lines 22-27: server system, network accessible) to enable said system to respond to a client request with information the client needs to make an initial connection to the server, (see Kikinis col. 4, lines 31-36; col. 3, lines 28-32: server (i.e. provisioning server) to configure apparatus (i.e. Internet appliance) resulting from client request) and
- b) Kikinis discloses a provisioning server. (see Kikinis col. 6, lines 3-4; col. 6, lines 9-12: server providing stored and storing addressing configuration information) Kikinis does not specifically disclose an automatic IP address configuration entity (i.e. DHCP server). However, O'Toole discloses an address server to automatically providing said client device with an Internet protocol address. (see O'Toole col. 7, lines 46-51; col. 18, lines 6-14: DHCP server for automatic IP address configuration)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kikinis to obtain a dynamic IP address for Internet communications access as taught by O'Toole. One of ordinary skill in the art would be motivated to employ O'Toole in order to remotely configure a network

connected (i.e. Internet) appliance obtaining its configuration information from a network server to achieve easier usage and greatly reduce administration costs. (see O'Toole col. 1, lines 19-21)

**Regarding Claim 12** (Previously Presented), Kikinis discloses an apparatus (i.e. internet appliance) with remote configuration capability. (see Kikinis col. 3, lines 22-27: apparatus (i.e. Internet device) capable of obtaining and installation of configuration information) Kikinis does not specifically disclose a dynamic address assignment (DHCP) capability. However, O'Toole discloses the system of claim 10 including a dynamic address (DHCP) server. (see O'Toole col. 7, lines 46-51; col. 18, lines 6-14: DHCP server for automatic IP address assignment)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kikinis to obtain a dynamic IP address for Internet network communications access as taught by O'Toole. One of ordinary skill in the art would be motivated to employ O'Toole in order to enable a network connected (i.e. Internet) appliance to remotely obtain configuration information from a network server to achieve easier usage and greatly reduce administration costs. (see O'Toole col. 1, lines 19-21)

**6. Claims 3, 11, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kikinis-O'Toole in view of Ylonen (US Patent No. 6,782,474).**

**Regarding Claim 3** (Previously Presented), Kikinis discloses an apparatus that

provides a pre-configured network connected appliance that is capable of obtaining its configuration information from server. (see Kikinis col. 3, lines 22-27: apparatus (i.e. Internet device) capable of obtaining and installing configuration information) Kikinis does not specifically disclose an out-of-band method such as e-mail, phone call, or any other non-network method for receipt of configuration and authentication information. However, Ylonen discloses the method of claim 2, further comprising: sending out-of-band data to a user of the client device prior to receiving the connection. (see Ylonen col. 7, lines 56-61; col. 9, lines 15-23: receive authentication information via out-of-band method)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kikinis to obtain access and authentication information via an out-of-band method as taught by Ylonen. One of ordinary skill in the art would be motivated to employ Ylonen in order to enable a network connected appliance to remotely and securely obtain configuration information from a network server. (see Ylonen col. 2, lines 55-56: “... *configuration methods for configuring network devices ... ease of use, robustness, and security ...*”; col. 2, line 67 - col. 3, line 7: “... *where security is an issue, it is desirable to be able to configure new network devices remotely and securely from a remote network management station ...*”)

**Regarding Claim 11** (Previously Presented), Kikinis discloses an apparatus (i.e. internet appliance) with remote configuration capability. (see Kikinis col. 3, lines 22-27: apparatus (i.e. Internet device) capable of obtaining and installation of configuration



information) Kikinis does not disclose a static address usage capability. However, Ylonen discloses the system of claim 10 including a static address server capability. (see Ylonen col. 4, lines 22-27: receipt of a static (i.e. pre-configured or pre-setup) address for a network node)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kikinis to obtain a static address for Internet access as taught by Ylonen. One of ordinary skill in the art would be motivated to employ Ylonen in order to enable a network connected (i.e. Internet) appliance to remotely and securely obtain configuration information from a network server. (see Ylonen col. 2, lines 55-56; col. 2, line 67 - col. 3, line 7)

**Regarding Claim 13 (New)**, Kikinis discloses an apparatus (i.e. internet appliance) with remote configuration capability. (see Kikinis col. 3, lines 22-27: apparatus (i.e. Internet device) capable of obtaining and installing configuration information) Kikinis does not disclose an out-of-band communications interface. Ylonen discloses the system of claim 10 including an out-of band communication interface. (see Ylonen col. 7, lines 56-61; col. 9, lines 15-23: receive authentication information via out-of-band method)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kikinis to obtain access and authentication information via an out-of-band method as taught by Ylonen. One of ordinary skill in the art would be motivated to employ Ylonen in order to enable a network connected (i.e. Internet) appliance to remotely and securely obtain its configuration information from a network

server. (see Ylonen col. 2, lines 55-56; col. 2, line 67 - col. 3, line 7)

**Conclusion**

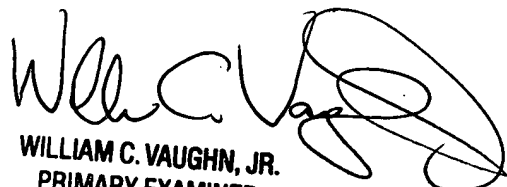
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyung H. Shin whose telephone number is (571) 272-3920. The examiner can normally be reached on 9 am - 7 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KHS  
Kyung H Shin  
Patent Examiner  
Art Unit 2143

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May 5, 2005

  
WILLIAM C. VAUGHN, JR.  
PRIMARY EXAMINER